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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/931,492

08/16/2001

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IPCP:107_US_

4008

24041 7590 06/30/2009
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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

06/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* THOMAS J. COLSON, JOHN E. CRONIN, SAMUEL C.
9 BAXTER, and ROBERT CANTRELL
10

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12 Appeal 2008-004539
13 Application 09/931,492
14 Technology Center 3600
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17 Decided:¹ June 30, 2009
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20 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
21 ANTON W. FETTING, *Administrative Patent Judges*.
22
23 CRAWFORD, *Administrative Patent Judge*.
24

25 DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44.² We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented systems and methods for publishing product information by placing documents describing the product and commercial availability thereof in a searchable database via the Global Information Network (Internet) (Spec. 1:9-12).

Claim 11, reproduced below, is further illustrative of the claimed subject matter:

11. A method of publishing a product document, said method comprising the steps of:

providing a searchable document database and a publication Web site in communication with said document database, where said database is publicly accessible;

electronically receiving a product document transmitted by a client's computer, where said product document provides information regarding a commercially available product;

publishing said product document by adding said product document to said document database, wherein said publishing is for the purpose of disclosing information about a product to

² Claims 17, 18, 39, and 40 are pending and objected to as being dependent upon a rejected based claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

1 establish a bar to patentability of inventions
2 practiced in said product; and,
3 digitally notarizing said product document
4 and obtaining a document notarization record, said
5 document notarization record including a
6 timestamp and a digital fingerprint.

7
8 The prior art relied upon by the Examiner in rejecting the claims on
9 appeal is:

10 Donner	US 6,154,725	Nov. 28, 2000
11 Rivette et al.	US 6,339,767 B1	Jan. 15, 2002
12 Khan et al.	US 6,401,206 B1	Jun. 4, 2002

13 The Examiner rejected claims 2-11, 13-16, 19-22, 24-33, 35-38, and
14 41-44 under 35 U.S.C. § 103(a) as being unpatentable over Rivette in view
15 of Donner and Khan.

16
17 **OPINION**

18 We have carefully reviewed the rejections on appeal in light of the
19 arguments of the Appellants and the Examiner. As a result of this review,
20 we have reached the conclusion that the applied prior art does not establish
21 the prima facie obviousness of the claimed subject matter. Therefore the
22 rejections on appeal are reversed. Our reasons follow.

23 The following comprise our finding of facts with respect to the scope
24 and content of the prior art. Rivette discloses system 302 including web
25 clients 304 communicating with databases 316 (Fig. 3) via web server 310
26 and enterprise server 314. Donner discloses an intellectual property audit
27 system where a user inputs data into input device 14 of the system, and then
28 database access device 16 of the system collects various data from different

1 on-line intellectual property databases 18 related to the data inputted into
2 input device 14 (Fig. 2; col. 4, l. 66 through col. 5, l. 58).

3 The disagreement between the Appellants and the Examiner is
4 whether a combination of Rivette and Donner renders obvious “a searchable
5 document database and a publication Web site in communication with said
6 document database, where said database is publicly accessible,” as recited in
7 independent claim 11 (App. Br. 8-10, 12-16; Ex. Ans. 4-5, 10-11; Reply Br.
8 5-9). The Examiner found that Rivette does not explicitly disclose that the
9 database is publicly accessible. The Examiner then asserts, however, that
10 Donner discloses that the database is publicly accessible (Ex. Ans. 4-5).³

11 Donner discloses a system that *collects* data from on-line intellectual
12 property databases that may be publicly accessible; however, Donner does
13 not disclose that the system *itself* and therefore the database within that
14 system is publicly accessible. Thus, the Examiner has erred in presenting a
15 prima facie case. The Examiner’s rationale for combining Rivette and
16 Donner, to form an IP portfolio utilizing material in the public domain, also
17 makes it clear that it is the system of Donner, which is not shown to be
18 publicly accessible, and not the source on-line intellectual property
19 databases that are entered into Donner’s system, being combined with
20 databases 316 of Rivette (Ex. Ans. 4-5).

21 Even assuming *arguendo* that databases 316 of Rivette were modified
22 to collect IP from the public domain, as set forth in the rationale for

³ We note that the Response to Argument’s section of the Examiner’s Answer does not directly address this argument, other than a passing reference on page 11 that “the Appellants arguments appear to be directed towards whether the database is publically accessible, which is a feature disclosed by the Donner reference.”

1 combining Rivette and Donner, the resulting combination is not that
2 databases 316 are publicly accessible. Accordingly, because the Examiner
3 has not established a prima facie case that a combination of Rivette and
4 Donner renders obvious “where said database is publicly accessible,” we do
5 not sustain the rejection of independent claim 11. *See In re Oetiker*, 977
6 F.2d 1443, 1445 (Fed. Cir. 1992) (during examination, the Examiner bears
7 the initial burden of establishing a prima facie case of obviousness).

8 By virtue of their dependence on independent claim 11, we also do
9 not sustain the rejection of claims 2-10, 13-16, 19-22 and 24-32.

10 Independent claim 33 recites “a searchable document database, where
11 said database is publicly accessible.” For the same reasons we do not
12 sustain the rejection of independent claim 11, we also do not sustain the
13 rejection of independent claim 33. By virtue of their dependence on
14 independent claim 33, we also do not sustain the rejection of claims 35-38
15 and 41-44.

16 17 CONCLUSION

18 The Appellants have shown that the Examiner erred in rejecting
19 claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44.

20
21 REVERSED

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24 mev

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